

REMARKS

In the Office Action mailed on January 5, 2004, the Examiner:

(1) rejected claims 1-3, 5-7, 11-18, 21-26, 28-31, 33-36, 41-44, 46-48, 52-59, 62-67, 69-72, 74-77, 83-91, 96, 97, 99, 100, 102-104, 107, and 109-111 under 35 U.S.C. § 102(e) as being anticipated by Hillebrand et al. (U.S. Patent No. 6,571,003; "Hillebrand et al.");

(2) rejected claims 4, 45, and 82 under 35 U.S.C. § 103(a) as being unpatentable over Hillebrand et al. in view of Goldberg (U.S. Patent No. 6,526,158; "Goldberg");

(3) rejected claims 8 and 49 under 35 U.S.C. § 103(a) as being unpatentable over Hillebrand et al. in view of Akiba et al. (U.S. Patent No. 6,377,745; "Akiba et al.");

(4) rejected claims 9, 10, 27, 50, 51, and 68 under 35 U.S.C. § 103(a) as being unpatentable over Hillebrand et al. in view of Akiba et al. and further in view of Donovan et al. (U.S. Publication No. 2003/0014324 A1, filed July 10, 2001; "Donovan et al.");

(5) rejected claims 19 and 60 under 35 U.S.C. § 103(a) as being unpatentable over Hillebrand et al. in view of Akiba et al. and further in view of Filo et al. (U.S. Patent No. 6,215,498; "Filo et al.");

(6) rejected claims 20 and 61 under 35 U.S.C. § 103(a) as being unpatentable over Hillebrand et al. in view of Wu et al. "Skin Aging Estimation by Facial Simulation," IEEE 1999 ("Wu et al.")

(7) rejected claims 32 and 73 under 35 U.S.C. § 103(a) as being unpatentable over Hillebrand et al. in view of Dirksing et al. (U.S. Patent No. 6,516,245; "Dirksing et al.");

(8) rejected claims 37-40, 78-81, and 92-95 under 35 U.S.C. § 103(a) as being unpatentable over Hillebrand et al. in view of Shaw et al. (U.S. Patent No. 6,320,583; "Shaw et al."); and

(9) rejected claims 98, 101, 105, 106, 108, 112, and 113 under 35 U.S.C. § 103(a) as being unpatentable over Hillebrand et al. in view of Hima et al. (EP 1134701 A2; "Hima et al.").

In sum, in the Office Action, the Examiner relied on Hillebrand et al. as the primary reference (either alone or in combination with certain other references) to reject pending claims 1-113. Applicants respectfully submit that the claimed subject matter is not taught by Hillebrand et al., alone or in combination with any of the other cited references, at least because of the following reasons.

1. **Rejection of claims 1-3, 5-7, 11-18, 21-26, 28-31, 33-36, 41-44, 46-48, 52-59, 62-67, 69-72, 74-77, 83-91, 96, 97, 99, 100, 102-104, 107, and 109-111 under 35 U.S.C. § 102(e)**

Focusing first on claim 1, that claim recites a method of constructing a body image, where the method includes prompting a subject to capture at least one body image of the subject and enabling the body image to be altered based on the subject's response to at least one prompt, to thereby reflect in the altered image the self-evaluation of the subject.

In contrast, Hillebrand et al. is directed to a skin imaging analysis system in which the need for a consumer or a beauty consultant to identify defects in the consumer's skin is eliminated by having a computer identify the skin defects. See e.g. col. 1, ll. 16-40 and 51-67. In the "Background of the Invention," Hillebrand et al. discusses a specific problem associated with having individual consumers determine the type of products to apply and how to best improve their personal skin type. (col. 1,

ll. 17-25). Next, in the same section, Hillebrand et al. discusses how beauty counselors at retail cosmetics counters are often responsible for identifying the skin defects and communicating the type, quantity, and location of those defects to the consumer for discussion. (col. 1, ll. 26-30). Noting that typically such consultations are very subjective, Hillebrand et al. states that not all beauty counselors identify the same type or number of skin defects. (col. 1, ll. 34-36). Thus, Hillebrand et al. aims to reduce the involvement of the consumer and the beauty counselor working with a skin imaging analysis system. Hillebrand et al. proposes a system in which a computer (controller 200, for example) analyzes skin defects without the subjective input of the consumer and the beauty counselor. (col. 4, ll. 38-54). As explained in the following passage set forth in Hillebrand et al. under the subheading "Overall Operation," the controller 200 performs skin defect identification and analysis.

In one embodiment, the programmed steps performed by the computing device 106 are executed by the controller 200. When the process 300 is initiated, the controller 200 acquires an image (step 302), determines which area(s) of the image to analyze (i.e., a sub-image) (step 304), analyzes those areas to locate defects (step 306), compares the severity of the located defects to an average skin severity or other statistical parameter associated with a population of people (step 306), displays the analysis results (step 308), and simulates an improvement and/or worsening to the defect areas (step 310).

(col. 4, ll. 42-53).

Thus, Hillebrand et al. does not teach a method of constructing a body image, where the method includes, prompting a subject to capture at least one body image of the subject and enabling the body image to be altered based on the subject's response

to at least one prompt, to thereby reflect in the altered image the self-evaluation of the subject, as recited in claim 1.

Claims 2, 3, 5-7, 11-18, 21-26, 28-31, and 33-36 depend, directly or indirectly, from claim 1 and thus are patentable at least for the reasons given above with respect to claim 1.

Regarding claim 41, Applicants respectfully submit that Hillebrand et al. does not teach a method of constructing a body image, including enabling a body image to be altered based on a subject's response to at least one prompt, to thereby reflect in the altered image the self-evaluation of the subject, for at least reasons similar to those discussed above with respect to claim 1.

Regarding claims 42 and 83, Hillebrand et al. does not teach a method of constructing an image of an external body condition, including causing presentation to a subject of at least one prompt prompting the subject to self-evaluate at least one of actual color and actual texture of the external body condition, for at least reasons similar to those discussed above with respect to claim 1.

Claims 43, 44, 46-48, 52-59, 62-67, 69-72, and 74-77 depend, directly or indirectly, from claim 42 and thus are patentable at least for the reasons claim 42 is patentable.

Regarding claim 84, Hillebrand et al. does not teach an electronic system for constructing an image of an external body condition, including prompt generating module for presenting to a subject at least one prompt prompting the subject to self-evaluate at least one of color and texture of the external body condition, for at least reasons similar to those discussed above with respect to claim 1.

Concerning claim 85, Hillebrand et al. does not teach a method of constructing a facial image, including enabling a subject to participate in selecting a new visual element to replace at least one identified bias element.

Claims 86-91 depend from claim 85 and thus are patentable at least for the same reasons as claim 85.

Concerning claim 96, Hillebrand et al. does not teach a method of constructing a body image, including causing presentation of at least one prompt prompting the subject to self-evaluate an actual condition of the subject's own body, for at least the reasons similar to those discussed above with respect to claim 1.

Claims 97 and 99 depend from claim 96 and thus are patentable for at least the reasons given above with respect to claim 96.

Regarding claim 100, Hillebrand et al. does not teach a method of enabling color-calibrating of a self-image for use in simulating a beauty product use, including prompting a subject to compare a color of a displayed image with an actual color of the subject, and enabling the subject to calibrate the color of the image when the subject perceives a differences between the displayed image and actual skin color. For example, as explained above with respect to claim 1, Hillebrand et al. is directed to a system in which the controller performs all of the analysis and/or modification of an image.

Claims 102-104 depend, directly or indirectly, from claim 100 and thus are patentable at least for the reasons given above with respect to claim 100.

Regarding claim 107, Hillebrand et al. does not teach a method of color-calibrating an image for use in simulating a beauty product use, including comparing

color of a displayed image with an actual color of a body region and calibrating the color of the image when a difference is perceived between the displayed image and the actual color of body region.

Claims 109-111 depend from claim 107 and thus are patentable at least for the reasons given above with respect to claim 107.

2. Rejection of claims 4, 45, and 82, under 35 U.S.C. § 103(a)

With respect to the rejection of claims 4, 45, and 82 under 35 U.S.C. § 103(a) as being unpatentable over Hillebrand et al. in view of Goldberg, Applicants respectfully request that the rejection be withdrawn because the Office Action does not set forth a *prima facie* case of obviousness. To establish a *prima facie* case of obviousness, three basic criteria must be satisfied. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify a reference or to combine references. M.P.E.P. § 2143. Second, there must be a reasonable expectation of success. Id. Third, the prior art reference (or references when combined) must teach or suggest all of the claim elements. Id. Moreover, the requisite teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in Applicants' disclosure. M.P.E.P. § 706.02(j) (citing In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d (BN'A) 1438 (Fed. Cir. 1991)).

Applicants respectfully submit that there is no *prima facie* case of obviousness because one of ordinary skill in the art would not have had any motivation or suggestion to combine the two references in the matter suggested by the Examiner. Goldberg is

directed to addressing deficiencies of existing picture taking systems at places such as Disneyland, so that visitors to such places can obtain pictures of themselves doing a number of different activities, such as standing next to a cartoon character or taking a roller coaster ride. (col. 1, l. 26 - col. 2, l. 14). To solve these problems, Goldberg proposes attaching a remote identification tag 49 to the shirt of a patron at Disneyland, for example, which can be used to identify the patron and a digital camera 63 can take pictures of the patron, which can be later picked up at a kiosk 75. (Fig. 2; col. 6, ll. 26-65). That disclosure is significantly different from the disclosure of Hillebrand et al. relating to a skin analysis system and method. A person of ordinary skill in the art would not have had any reason to combine such non-analogous arts and thus claims 4, 45, and 82 are patentable for at least this reason.

3. Rejection of claims 8 and 49 under 35 U.S.C. § 103(a)

Concerning the rejection of claims 8 and 49 under 35 U.S.C. § 103(a) as being unpatentable over Hillebrand et al. in view of Akiba et al., Applicants respectfully request that the rejection be withdrawn because the Office Action does not set forth a *prima facie* case of obviousness. As noted above, to establish a *prima facie* case of obviousness, three basic criteria must be satisfied, including the requirement to establish suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify a reference or to combine references. Applicants respectfully submit that there is no *prima facie* case of obviousness because one of ordinary skill in the art would not have had any

had any motivation or suggestion to combine the two references in the manner suggested by the Examiner.

Akiba et al. is directed to a system for reproducing video data from multiple channels and to index the video data generated from the multiple channels. (Abstract). That disclosure is significantly different from the disclosure of Hillebrand et al. relating to skin analysis. A person of ordinary skill in the art would not have had any reason to combine such non-analogous arts and thus claims 4 and 89 are patentable for at least this reason.

4. Rejection of claims 9, 10, 27, 50, 51, and 68 under 35 U.S.C. § 103(a)

With respect to the rejection of claims 9, 10, 27, 50, 51, and 68 under 35 U.S.C. § 103(a) as being unpatentable over Hillebrand et al. in view of Akiba et al. and further in view of Donovan et al., Applicants respectfully request that the rejection be withdrawn because the Office Action does not set forth a *prima facie* case of obviousness. In particular, one of ordinary skill in the art would not have had any motivation or suggestion to combine the three references in the manner suggested by the Examiner. As noted above, Akiba et al. is directed to a system for reproducing video data from multiple channels and to index the video data generated from the multiple channels. (Abstract). That disclosure is significantly different from the disclosure of Hillebrand et al. relating to skin analysis. A person of ordinary skill in the art would not have had any reason to combine such non-analogous arts and thus claims 4 and 89 are patentable for at least this reason.

Further, Donovan et al. is directed to providing a customized retail product to a customer based on the customer's preferences. (Fig. 1; col. 1, paragraphs 0002-0008). That disclosure and the disclosure of Akiba et al. are significantly different from the disclosure of Hillebrand et al. relating to skin analysis. A person of ordinary skill in the art would not have had any reasons to combine such non-analogous arts and thus claims 9, 10, 27, 50, 51, and 68 are patentable for at least this reason.

5. Rejection of claims 19 and 60 under 35 U.S.C. § 103(a)

With respect to the rejection of claims 19 and 60 under 35 U.S.C. § 103(a) as being unpatentable over Hillebrand et al. in view of Akiba et al. and further in view of Filo et al., Applicants respectfully request that the rejection be withdrawn because the Office Action does not set forth a *prima facie* case obviousness. As discussed above, Akiba et al. is directed to a system for reproducing video data from multiple channels and to index the video data generated from the multiple channels. (Abstract). That disclosure is significantly different from the disclosure of Hillebrand et al. relating to skin analysis. A person of ordinary skill in the art would not have had any reason to combine such non-analogous arts and thus claims 19 and 60 are patentable for at least this reason.

Further, Filo et al. is directed to a network computer based system for creating a virtual work environment such that the participants at various levels of emersion within the virtual work environment are able to perform complimentary, independent, and cooperative task in parallel. (col. 1, ll. 4-10). That disclosure is significantly different from the disclosure of Hillebrand et al. relating to skin analysis. A person of skill in the

art would not have had any reason to combine such non-analogous arts and thus claims 19 and 60 are patentable for at least this additional reason.

6. Rejection of claims 20 and 61 under 35 U.S.C. § 103(a)

With respect to the rejection of claims 20 and 61 under 35 U.S.C. § 103(a) as being unpatentable over Hillebrand et al. in view of Wu et al., Applicants respectfully request that the rejection be withdrawn because the Office Action does not set forth a *prima facie* case of obviousness. Applicants respectfully submit that a person of ordinary skill in the art would not have had any reason to combine these references but for the benefit of hind-sight and the Applicants' disclosure and thus claims 20 and 61 are patentable for at least this reason.

7. Rejection of claims 32 and 73 under 35 U.S.C. § 103(a)

Concerning the rejection of claims 32 and 73 under 35 U.S.C. § 103(a) as being unpatentable over Hillebrand et al. in view Dirksing et al., Applicants respectfully request that the rejection be withdrawn because the Office Action does not set forth a *prima facie* case of obviousness. Dirksing et al. is directed to a method and an apparatus for providing a consumer with personalized beauty care cosmetic products. (col. 1, ll. 6-8). To achieve this objective, as shown in Fig. 2A, cartridges 220 house fluids, which can be combined in consumer specified quantities to produce a customized cosmetic product. (See Fig. 2A, col. 4, ll. 18-34). That disclosure is significantly different from the disclosure of Hillebrand et al. relating to skin analysis. A

person of ordinary skill in the art would not have had any reason to combine these references and thus claims 32 and 73 are patentable for at least this reason.

8. Rejection of claims 37-40, 78-81, and 92-95 under 35 U.S.C. § 103(a)

With respect to the rejection of claims 37-40, 78-81, and 92-95 under 35 U.S.C. § 103(a) as being unpatentable over Hillebrand et al. in view of Shaw et al., Applicants respectfully request that the rejection be withdrawn because the Office Action does not set forth a *prima facie* case of obviousness. Shaw et al. is directed to methods and apparatuses for changing the elements of an image through the use of one or more sets of modification data in real time. (col. 1, ll. 14-17). As disclosed in Fig. 9 of Shaw et al., an image transformation system 900 can take various inputs 937-939 and change a neutral geometry 933 of an image to a final geometry 935. (col. 6, ll. 43-63). That disclosure is significantly different from the disclosure of Hillebrand et al. relating to skin analysis. A person of ordinary skill in the art would not have had any reason to combine such non-analogous arts and thus claims 37-40, 78-81, and 92-95 are patentable for at least this reason.

9. Rejection of claims 98, 101, 105, 106, 108, 112, and 113 under 35 U.S.C. § 103(a)

With respect to the rejection of claims 98, 101, 105, 106, 108, 112, and 113 under 35 U.S.C. § 103(a) as being unpatentable over Hillebrand et al. in view of Hima et al., Applicants respectfully request that the rejection be withdrawn because the Office Action does not set forth a *prima facie* case of obviousness. Hima et al. is directed to a three-dimensional beauty simulation client-server system to carry out beauty simulations based on a user's face model data. (col. 1, paragraph 0001).

Applicants respectfully submit that a person of ordinary skill in the art would not have had any reason to combine these references but for the benefit of hind-sight and the Applicants' disclosure and thus claims 98, 101, 105, 106, 108, 112, and 113 are patentable for at least this reason.

Applicants respectfully request reconsideration of this application, withdrawal of the claim rejections, and the timely allowance of the pending claims.

The Office Action contains numerous statements reflect apparent assertions concerning the claims and/or the related art. Regardless of whether any such statement is addressed specifically herein, Applicants decline to subscribe to any assertion and/or characterization set forth in the Office Action.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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Dated: April 2, 2004

By: _____



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